UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,196	10/28/1999	STEVEN D. FAUST	V5735	5642

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EXAMINER
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ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 March 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 October 1999</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)   4)☒ Interview Summary (PTO-413) Paper No(s). <u>8</u> .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

DETAILED ACTION

Response to Amendment

1.   In papers filed on March 27, 2003, applicant made a minor correction to specification.

New drawings were also received indicating the figure numbers, thus objection to the drawings

is removed.

Response to Arguments

2.   Applicant argues that Freedman does not, and cannot, actually produce the product and

therefore Freedman does not teach or disclose *"a means for automatically formatting"* because a

means for automatically formatting is required only when a product is actually produced.

Examiner respectfully disagrees and takes the attention of the applicant to column 6, lines 55-63

where Freedman discloses a printer facility terminal 36 that can be used in small printing

companies having only a single location or plurality of such terminals used by larger printing

facilities. Having directed the print jobs to these terminals, it would have been obvious to output

the print job to these printing terminals, which include printer 40 for printing of the job.

Therefore, contrary to applicant arguments a print product can be actually produced at the

printing facility.

Applicant argues that Freedman does not disclose as claim 1 recites *"means for automatically*

formatting data on said electronic graphic template according to said customer's corporate

identity specification to form a populated and formatted template."

Examiner disagrees and would like to present column 8, lines 21-24 to show that Freedman

teaching "a requester selecting a printing parameter design template which have been previously

established for a particular type of printing job" is equivalent to customer corporate identity

specification. And Freedman's teaching for " ... batch loading the entire manuscript into the

computer in the desired form" in column 8, lines 45-48 equates to automatic formatting of data

on electronic graphic template.

As noted above Freedman teaches selection of printing templates that have been established and

then loading the printing data into the template for output as deigned by the template.

Although Freedman also discloses pricing information associated with the job and selection of

suitable printing facility, such disclosures are not the sole disclosures of Freedman as applicant

would like to assert.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Freedman (US patent 4,839,829).

Regarding claim 1, Freedman discloses an automated typesetting system used for

production of a commercially-printed product according to a customer's corporate identity

specifications, comprising:

means for creating, designing, storing, accessing, and updating an electronic graphic

template of the product according to the customer's corporate identity specifications (Fig. 1A;

column 8, lines 21-45 & 56-68);

means for creating, designing, programming, storing, accessing, and updating an electronic

database file, wherein said database file is programmed to receive and store populating data used

to populate said template and said database file is further programmed with instructions and

parameters used to format said populating data on said template according to the customer's

corporate identity specifications (column 7, lines 37-52 and column 8, lines 21-24); means for

inputting said populating data into said database file as database records (Figure 1A, terminals 14

and 38) ; means for automatically populating said populating data into said template (column 8,

lines 45-48); and means for automatically formatting said populating data on said electronic

graphic template according to the customer's corporate identity specifications to form a

populated and formatted template (column 8, lines 40-44). Freedman refers to the programmed

computer 20 for storage of database containing the information for a job. The programmed

computer also holds the software for running this application. Although Freedman may not

clearly state printing of the product, it states in column 6, lines 55-63 that a printing terminals 36

in small and large printing facilities are employed in a single location or multiple locations which

include printer 40. Therefore, it would have been obvious to a person skilled in the art, at the

time of invention to utilize such printing terminals to produce the print job.

Regarding claim 2, Freedman discloses an automated typesetting system of claim 1

further comprising a means for automatically printing said populated and formatted template

(column 7, lines 58-61 and column 8, lines 45-48).

Regarding claim 3, Freedman discloses an automated typesetting system of claims 1 or 2, in which said template is comprised of at least one block designed to contain populating data in the form of text or graphics. In column 8, lines 36-44 Freedman teaches different manuscript formats like book and newsletter. Such formats allow for text and graphics. He also teaches accepting scanned graphics in column 8, lines 19-21.

Regarding claim 4, Freedman discloses an automated typesetting system of claims 1 or 2, in which said database file is comprised of at least one field designed to contain populating data and at least one field designed to contain instructions and parameters used to format said populating data on said template according to the customer's corporate identity specifications. Freedman considers in column 7, lines 37-58 all parameters for printing a job. Such parameters in the printing environment include data and format information.

Regarding claim 5, Freedman discloses an automated typesetting system of claims 1 or 2, in which said means for creating, designing, storing, accessing, and updating an electronic graphic template comprises a computer software program and said means for creating, designing, programming, storing, accessing, and updating an electronic database file comprises a computer software program (column 3, lines 57-62). The programmed computer 20 contains the software/program for executing the function described in his invention.

Regarding claim 7, Freedman discloses an automated typesetting system of claims 1 or 2

further comprising a means for electronically proof checking and correcting said populating data

prior to automatically populating said populating data into said template (column 9, lines 18-22).

Regarding claim 8, Freedman discloses an automated typesetting system of claims 1 or 2,

in which said means for automatically populating said populating data into said template further

comprises a means for fully populating said template should said populating data not fully

populate said template (column 11, lines 36-38). Freedman also teaches that print manager has

the ability to add additional information in the computer such as special stock dimension, color

or plate size to complete the job.

Regarding claim 9, Freedman discloses an automated typesetting system of claims 1 or 2

interactively coupled with an automated order tracking, billing, shipping, and inventory control

system (column 8, lines 1-9; column 10, lines 15-24, 36-38, 55-63; column 11, lines 1-50).

5.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman in view

of Cupps et al. (U.S. Patent 5,991,739).

Regarding claim 6, Freedman does not discloses an automated typesetting system of

claims 1 or 2, in which said means for inputting said populating data into said database file as

database records comprises:

a Web site programmed to receive said populating data; and a populating data import means for

automatically importing said populating data into said database file as database records.

Cupps et al. discloses an Internet on line order service wherein a customer is given access to a

web site to facilitate ordering (column 2, lines 19-38; column 4, lines 60-68 and column 5, lines

1-5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of

invention to modify Freedman wherein the on-line communication link is the Internet. It would

have been obvious to a person skilled in the art to combine teaching of Cupps et al. with

Freedman et al. to provide customers with greater access to the system from remote locations.

Contact Information

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 703-306-3473.

The examiner can normally be reached on Mon.-Fri. 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9314 for regular

communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3800.

Alan Rahimi
May 29, 2003

EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER